



Docket No. 12969

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Bitler

09,810,920

Group Art Unit: 1714

Serial No.: ~~09/398,377~~

Examiner: Szekely, P.

Filing Date: 09/17/99

Title: Polymeric Thickeners for Oil-Containing Compositions

Assistant Commissioner for Patents

Washington, DC 20231

**REPLY**

Sir,

**INTRODUCTORY COMMENTS**

This paper is a reply to the Office Action mailed March 31, 2003. Reexamination, reconsideration and allowance are respectfully requested in view of the Amendments and Remarks below. This reply has been prepared in accordance with the recently promulgated Revised Amendment Format.

**Telephone Interview**

A brief telephone interview took place on June 12, 2003, between the Examiner and the undersigned. Before the interview, the Examiner had been provided with a draft Reply. During the interview, the Examiner indicated that after amendment in the way proposed in the draft Reply and the filing of a terminal disclaimer, the previously rejected claims containing numerical ranges for the amount of the thickening agent

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would be allowable, but that the rejected claims specifying that the thickening agent is present in amount sufficient to thicken the composition would not be allowable. Applicant is not willing to limit the rejected claims to those containing numerical ranges.

The undersigned did not clearly understand other positions taken by the Examiner during the interview. Insofar as the undersigned was able to understand those positions, they appeared to be as follows.

- (1) The Examiner had earlier withdrawn his objection that it was new matter to state that the thickening agent was "present in amount sufficient to thicken the oil" because of the disclosure in Morawsky U.S. Patent No. 5,736,125, which was incorporated by reference in this application.
- (2) In view of (1) above, and because Morawsky discloses a range of 0.1 to 12% for the amount of the thickening agent, the Examiner construes the claims specifying that the thickening agent is present in amount sufficient to thicken the oil as being limited to the use of 0.1 to 12 % of the thickening agent.
- (3) Because Morawsky provided the basis for the requirement in some of the rejected claims that the thickening agent was present in amount sufficient to thicken the composition, it is clear that Morawsky is relevant to the rejection of those claims under 35 U.S.C. 102 and 103.

The amendments requested in the present Reply are the same as those requested in that draft Reply, with the following exceptions.

1. Claims 42 and 50 have not been canceled, but rather have been amended to specify that the amount of the SCC polymer is 0.1 to 12 % by weight (i.e. the preferred range of concentration disclosed in Morawsky U.S. Patent No. 5,736,125).
2. The requested amendment to the paragraph on page 9, lines 12-14, now refers to the amount of the polymeric thickener being sufficient to thicken the composition to the desired thickness, for example 0.1 to 12% by weight of the oil.

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This amendment reflects the disclosure on page 3, lines 19-22 of Morawsky U.S. Patent No. 5,736,125.

The arguments presented in the present Reply are similar to those presented in the draft Reply, but have been amended and amplified as to the issues which appear, from the telephone interview, to be at the root of the outstanding rejections.

### **Construction of Rejected Claims, and Conditional Petition**

Applicants believe that it is important that the record should be clear as to the meaning of the claims requiring that the thickening agent is present "in amount such that it thickens the oil". If paragraph (2) above, summarizing statements made by the Examiner during the interview, is correct, there is a fundamental difference between the Examiner's and the Applicant's constructions of those claims. As explained previously, and again in the attached Petition, Applicant believes that the claims in question cover the use of any amount of thickening agent which will in fact thicken the oil, i.e. the use of amounts which may be outside the range of 0.1 to 12%. If the Examiner, after consideration of this Reply and the attached Petition, agrees that the claims in question cover the use of any amount of thickening agent which will in fact thicken the oil, i.e. the use of amounts which may be outside the range of 0.1 to 12%, he is asked to state that agreement on the record. If, however, the Examiner is not prepared to state such agreement on the record, he is asked to forward the attached Petition to the Petitions Branch.

**Basis for the limitation that the thickening agent is present in amount such that it thickens the oil.**

As noted in paragraph (2) above, in the telephone interview, the Examiner stated (insofar as the undersigned was able to understand what the Examiner said) that he had had earlier withdrawn his objection, that it was new matter to require that the thickening agent was "present in amount sufficient to thicken the oil", because of the

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disclosure in Morawsky U.S. Patent No. 5,736,125, which is incorporated by reference in this application. Applicant believes that the proper construction of the claims in question is not dependent on the Examiner's rationale for withdrawing the objection. However, in case the Examiner thinks otherwise, the following points are noted.

1. Paragraphs 1 and 2, on pages 14-17 of the Reply mailed September 27, 2002, and paragraphs 1 and 2, on pages 1-3 of the Supplemental Reply mailed Oct. 27, 2002, set out in detail Applicant's reasons for believing that the requirement in question did not involve new subject matter or result in the claims which should be rejected for lack of enablement. One of the reasons was the incorporation by reference of Morawsky U.S. Patent No. 5, 736,125. The majority of the reasons focused on other relevant disclosure in the specification as filed.
2. Applicant believes that, even in the absence of the incorporation by reference of Morawsky, no new subject matter is involved in the requirement that the thickening agent should be present in amount sufficient to thicken the oil.

For the sake of completeness, the following additional points are noted.

3. Page 2 of the Office Action mailed November 25, 2002, after the Examiner had considered the arguments set out in the Reply mailed September 27, 2002, and the Supplemental Reply mailed Oct. 17, 2002, states:

*The Examiner acknowledges that Morawsky..., incorporated by reference, does contain the phrase 'present in amount sufficient to thicken the composition' in column 3, lines 19-24, so that limitation is not new matter. Since the (Morawsky) Patent defines that amount 0.1-12% by weight, the phrase will be interpreted as such.*

4. Pages 13-14 of the Reply mailed January 27, 2003, discusses the above-quoted passage in the Office Action mailed November 25, 2002, noting, with reasons, why the requirement should not be interpreted to mean that the amount is 0.1 to 12%, and asking the Examiner to state on the record that further

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examination of the claims in question had been carried out on the basis that the phrase "in an amount sufficient to thicken the composition" in Morawsky and the corresponding phrase "in amount such that it thickens the oil" in the claims mean simply what they say and are not limited to amounts in the range of 0.1 to 12%.

5. The outstanding Office Action makes no comment on the meaning of the claims in question.

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